



UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/782,286	08/23/96	ANDERSON	E P1969/JAS-55

LMC1/0407

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EXAMINER	
HARRINGTON, A	
ART UNIT	PAPER NUMBER
2712	19

DATE MAILED:

04/07/00

Below is a communication from the EXAMINER in charge of this application  
COMMISSIONER OF PATENTS AND TRADEMARKS

#### ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☒ is extended to run \_\_\_\_\_ or continues to run 3 months from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.
- Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 3-27-00 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
  - b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
  - c. ☐ They raise the issue of new matter. (See Note).
  - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☐ Upon the filing an appeal, the proposed amendment ☐ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: \_\_\_\_\_

Claims objected to: \_\_\_\_\_

Claims rejected: \_\_\_\_\_

However;

☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because see attached

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

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### DETAILED ACTION

The declaration filed on 3/27/00 under 37 CFR 1.131 has been considered but is ineffective to overcome the Itoh (US 5,966,122) reference.

The declaration must establish possession of the **whole** invention, not just a part of it, see MPEP section 715.02. Therefore, affidavit or declaration showing must establish possession of the invention (the basic inventive concept) and not just of what one reference happens to show, if the reference does not itself teach the basic inventive concept.

Secondly, the declaration must include more than merely conclusions. Any conclusion must be supported by facts. In the present declaration, Mr. Anderson states the conclusion that he had conceived the "mark function" idea prior to 8/9/96. As supporting evidence, a letter from Mr. Anderson's attorney is supplied, documenting a "patent application is being submitted for review of 8/8/96. However, the subject matter of this application at that time, can not be ascertained. Without this, factual support for Mr. Anderson's conclusion is not substantiated.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Harrington whose telephone number is (703) 308-9295. The examiner can normally be reached on Tuesday to Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Wendy Garber, can be reached on (703) 305-4929.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-6306, (for formal communications intended for entry)

**Or:**


(703) 308-6296 (for informal or draft communication, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor ( Receptionist)

AMH:



April 4, 2000



Wendy Garber  
Supervisory Patent Examiner  
Technology Center 2700